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A-S

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/625,148	07/25/00	MIYAMOTO Y	OPS CASE 498

IM52/0314

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EXAMINER	
HOWARD,J	
ART UNIT	**PAPER NUMBER**
1764	3

DATE MAILED: 03/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/625,148	Yasuhiro Miyamoto et al
Examiner	**Group Art Unit**
Jacqueline V. Howard	1764

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-7 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-7 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the additional components recited at page 6 of the specification, does not reasonably provide enablement for the vast number of materials encompassed by the claimed terminology. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The recitation "a fourth component " reads on a vast number of materials not having basis in the specification. Applicants should identify the fourth component as conventional additives in grease compositions, or some similar language having basis in the specification.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CAR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

Claims 1 to 7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6 to 8 and 27 of copending Application No. 09/349,465. Although the conflicting claims are not identical, they are not patentably distinct from each other because the recitation "additive" in the '465 application encompasses the organomolybdenum compounds of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 to 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morway et al (2,739,127) combined with Doner et al(5,763,370) or Tanaka et al (5,858,931) and Denton (5,668,092).

The reference to Morway et al teaches lubricating grease compositions comprising organic carbonates. Note col. 2 lines 14 to 30 and lines 65 to 69 for teaching of a carbonate which is the same as component (I) of the instant claims. Inclusion of a lithium soap thickener is taught at col. 4 lines 72 to 74. Other conventional modifying agents may be added to the grease. See col. 5 lines 4 to 10. The references to Doner and Tanaka teach the use of molybdenum dittiocarbamate and molybdenum dithiophosphate as conventional enhancing additives in grease

compositions. The references do not specifically teach use of the grease composition for a bearing of information devices. However Denton teaches it is conventional to seal bearings containing grease. See especially col. 4 lines 30 to 35.

It is the examiner's position that the instant claims would be prima facie obvious in view of these references. To use a known grease in a conventional environment would be obvious to one of ordinary skill in the art. It is not unobvious to follow the teaching of the prior art.

The references cited but not applied further teach using carbonates and molybdenum compounds in lubricating compositions.

Any inquiry concerning this communication should be directed to J. Howard at telephone number (703) 308-2514.

JACQUELINE V. HOWARD
PRIMARY EXAMINER
GROUP 1700

J. Howard/dh

March 13, 2001